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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,305	01/23/2002	Hoon Bum Lee	B-4475 619477-6	1950
36716	7590	12/01/2004		
LADAS & PARRY				
5670 WILSHIRE BOULEVARD, SUITE 2100				
LOS ANGELES, CA 90036-5679				

EXAMINER	
PANTUCK, BRADFORD C	

ART UNIT	PAPER NUMBER
3731	

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,305

Applicant(s)

LEE, HOON BUM

Examiner

Bradford C Pantuck

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 1, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 7-9, 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-15, 18 and 19 is/are rejected.
- 7) ☒ Claim(s) 6 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).
Correction of the following is required: the term “magnetically operated *plunger* type” (or similar language) is not found in the specification. There is no such plunger described in the specification.
2. The amendment filed February 20, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Claim 14 claims a “magnetically operated *plunger* type”. There is no reference to a magnetic plunger component of the invention in the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. It is unclear what a "magnetically operated power transmitting member" is. It is suggested that Applicant amend the claim to set forth a "power transmitting member driven by a motor" if that is indeed what Applicant intends.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 10-13, 15, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,251,641 to Xavier in view of U.S. Patent No. 5,961,534 to Banik et al. Regarding Claim 1, Xavier discloses a biopsy device having a first cutting member (12) [Fig. 7] and a second cutting member (28) [Fig. 8]. Although Xavier's device is not meant to perform a hair-transplanting procedure, his device matches the structure of Applicant's invention and is thus capable of such a surgery. The device is intended to cut through tissue fairly atraumatically and remove it from the body [Column 1, lines 18-23].

As shown in Figure 8, Xavier's first cutting member (28) has an elongate and hollow shape [Column 2, lines 20-28]. This cutting member (28) has a blade (36/38/42) at its front end [Column 2, lines 41-49]. This sharpened distal part of component (12) is certainly capable of piercing the skin of the scalp. Portion (42) of

Art Unit: 3731

the blade forms an entrance to the cutting member and inclines towards one side, as is most clearly evident from Figure 3. The surface (42) outlines an "imaginary portion," which is the plane of the entrance to part of the distal end of the cutting member (28). Part (36), on the other hand, is *flat* and does not incline.

As is shown in Figure 1, Xavier's second cutting member (12) has an elongate and hollow shape, and can move forwards and backwards [see Fig. 4 especially; Column 2, lines 28-35]. It has a blade (20/22/26) at its distal end. The blade of the first cutting member (28) meets and faces the blade of the second cutting member (12) when they are adjacent to each other [see Fig. 6; Column 3, lines 14-21].

Xavier's assembly includes a housing (44/46) [Column 2, lines 50-59]. His assembly does not include an extrusion member to push a hair graft out of the cannula, and he says merely that the tissue can be removed from the device [Column 4, lines 36-44]. However, Banik discloses another biopsy device with a rotating cutter at its front end. Banik teaches that one ought to have a central extrusion member (25) for removing the biopsy samples collected in the central storage space [Column 3, lines 37-41; Figure 2]. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to include an extrusion member with the device of Xavier in order to push the collected biopsy sample out of the holding chamber for inspection by the medical personnel, as taught by Banik.

5. Regarding Claim 2, Xavier discloses a first cutting member (12) with a blade surface having a semi-elliptical shape [see Fig. 7]. Particularly cutting component (26) has a semi-elliptical shape. The second cutting member (28) has a face of its

own blade (as all blades do), which is approximately opposite to the face of the first cutting member's face.

6. Regarding Claim 3, the axis of the blade surface (26) of the first cutting member (12) inclines a little bit (slightly) [see Fig. 4].
7. Regarding Claim 4, as the two members revolve with respect to each other, the opening at the front end of the device becomes closed, as shown in Figure 6 and described in Column 3, lines 22-30.
8. Regarding Claim 5, Banik's extruding member is made from a flexible material and its end protrudes from the first cutting member [Banik: Fig. 2]. In Figure 2 the extruding member is shown moving forward, and the extruding member can be pushed further up to extend out of the hole (29) [Banik: Column 4, lines 30-33]. The extruding member would be arranged in a similar fashion in the modified Xavier device.
9. Regarding Claims 10 and 11, Xavier's device is intended to perform a biopsy of body tissue [Column 1, lines 6 and 7].
10. Regarding Claims 12 and 13, Xavier's cutting member (28) meets all the respective limitations of the "first cutting member" and the "second cutting member" as claimed in claim 1. Xavier's cutting member (12) also meets all the respective limitations of the "first cutting member" and the "second cutting member" as claimed in claim 1.

11. Regarding Claim 15, an operating handle (46) is attached to the cutting members in such a way that turning it will cause the cutting members to move in opposite directions [Column 2, lines 50-54].
12. Regarding Claims 18 and 19, Xavier's Figure 6 shows opposing blades, facing each other, with surfaces rotated 180 degrees with respect to each other.

Allowable Subject Matter

13. Claims 6 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Response to Arguments

15. Applicant's arguments, see "REMARKS/ARGUMENTS", filed 10/01/2004, with respect to the objection to the Oath/Declaration have been fully considered and are persuasive. The objection has been withdrawn. Additionally, the rejections under 35 USC § 112 have been withdrawn as a result of the Applicant's amendments and the Examiner's reconsideration.
16. Applicant's arguments filed 10/01/2004 with respect to the new matter rejection of Claim 14 have been fully considered but they are not persuasive. Examiner maintains his rejection of Claim 14 because *nowhere in the specification* does Applicant describe a "magnetically operated plunger type."

Applicant argues that the disclosure contains an "electric motor," and (apparently) that the magnetic plunger is a part of an electric motor. Examiner does not agree with this characterization of a plunger. Generally speaking, a plunger is a power *transmitting* member and a motor is a power *generating* member. In all embodiments of the specification, Applicant corroborates this reasoning, calling out an electric motor and a *separate* power-transmitting member. For example, on page 13, lines 1-2, Applicant describes a "power-transmitting member *linked to* an electric motor" [emphasis added by Examiner].

Therefore, claiming "a power transmitting member *is* a magnetically operated plunger type" [emphasis added by Examiner] is new matter. Claiming a plunger *driven by* a motor or other means would not be new matter.

17. Applicant's arguments filed 10/01/2004 with respect to the rejection under 35 USC § 103 have been fully considered but they are not persuasive. Inserting an extrusion member into the device of Xavier is obvious, as taught by Banik, as explained above. Banik's invention is in the same art as Xavier's invention, and Banik provides a motivation for having an extrusion member, "for removing the samples from the storage space" [column 3, lines 38-42]. Applicant's argument that the modified Xavier device is not meant for a hair transplant is not efficacious, as the device is capable of such an intended use.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford C Pantuck whose telephone number is (571) 272-4701. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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November 23, 2004

[Signature]
ANH TUAN T. NGUYEN
PRIMARY EXAMINER
11/27/04